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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,102	07/09/2003	Hans Schmotzer	MEISS71.007DV1	1655
20995	7590	03/31/2005	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			PELLEGRINO, BRIAN E	
2040 MAIN STREET			ART UNIT	
FOURTEENTH FLOOR			PAPER NUMBER	
IRVINE, CA 92614			3738	

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/616,102

Applicant(s)

SCHMOTZER ET AL. 

Examiner

Brian E Pellegrino

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/25/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on 3/2/99. It is noted, however, that applicant has not filed a certified copy of the 29903766.5 application as required by 35 U.S.C. 119(b).

### ***Information Disclosure Statement***

The information disclosure statement filed 8/25/03 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is *not in the English language*. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Specification***

The disclosure is objected to because of the following informalities: Claims should not be referred to in the specification. If claims were canceled, the specification would also require amending to correct for any canceled claim. Appropriate correction is required.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the limitations of the "previously-determined distance" being between "about 26.4mm and about 37.44mm" or "about 32mm" or between "about 30.45mm and about 33.35mm" was not found in the written disclosure.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 13,14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation in claim 13 that the "previously-determined distance is between about 26.4mm and **about 37.44mm**" is not supported in the specification. The written disclosure on page 3, line 12 provides support for *up to 34mm*, but not beyond that.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims are 1,2,5,6,16,18,19 are rejected under 35 U.S.C. 102(b) as being anticipated by D'Antonio (5810831). Fig. 1 shows a slideway with two convexly curved condyles and inherently has a patella shield. Fig. 2 illustrates that the femur has two holes drilled for pegs located on the slideway. D'Antonio discloses that surgeons remove more bone from the dorsal side of the femur than replaced by the slideway, col. 1, lines 53-64. D'Antonio also discloses (col. 5, lines 40-42) using a template to size the femur and shows (Fig. 2) at least one bore 60 separated by a pre-determined distance. It is inherent that the slideway is fitted onto the femur and that pegs are inserted into the holes formed in the femur.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3,4,7,9-15,17,20,21 are rejected under 35 U.S.C. 103(a) as being unpatentable over D'Antonio '831. D'Antonio is explained supra. However, D'Antonio

fails to disclose the pre-determined distance between the condyles and a point located on the femur being "about" 5-15% larger than the dimension of the between the peg and prosthesis condyles. It would have been an obvious matter of design choice to modify the amount of slideway surface provided for articulation, since applicant has not disclosed that using a larger amount provides any advantage, or solves a stated problem, or is used for any particular purpose. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with distance provided in the preparation of the femur taught by D'Antonio or the claimed 10% in claim(s) 4,10,21 because both procedures perform the same function of taking into consideration the anatomy conditions of the patient and the articulation of the prosthesis with respect to the ligaments. With respect to claim 7, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a slideway having about 2-5% dimension of a distance between a dorsal sliding surface and a ventral sliding surface, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable range involves only routine skill in the art. Regarding claim 17, it would have been obvious to one having ordinary skill in the art at the time the invention was made to resect about 10% more bone from the dorsal side of the femur, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. With respect to claims 11-15, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a distance between the peg and dorsal sliding surface of the slideway having a range between 24-34mm, since it has

been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over D'Antonio '831 in view of Colleran et al. (5776201). D'Antonio is explained supra. However, D'Antonio fails to disclose providing a group of slideways with different dorsal condyle-to-ventral condyle distances. Colleran et al. teach (Fig. 4) a group of slideways is provided in a surgical procedure to prepare a femur for implanting a prosthesis. Colleran teaches the femoral prostheses are different sizes, col. 2, lines 54-56. It would have been obvious to one of ordinary skill in the art to use a plurality of femoral prostheses as taught by Colleran et al. in D'Antonio's method of surgery on a femur such that the surgeon has a proper fitting prosthesis for the patient since all patients are going to have different anatomical features.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E Pellegrino whose telephone number is 571-272-4756. The examiner can normally be reached on Monday-Thursday from 6:30am to 4pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached at 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TC 3700, AU 3738

**BRIAN E. PELLEGRINO**  
**PRIMARY EXAMINER**

*Brian E. Pellegrino*